

**REMARKS**

Claims 21-46, and 48-52, are pending. Claim 52 is withdrawn. Claims 29-30 have been amended to describe a bimodal system without reference to claim 21. Claims 40-43 have been amended to resolve 112 issues.

In paragraph 2 of the Office Action, all claims are rejected pursuant to 35 USC 112 based on a new matter rejection of the language added in the amendment of November 26, 2004. The language of concern has been removed from the claims.

In paragraph 3 of the Office Action, Claims 29-32, 40-43, and 54 stand rejected under 35 U.S.C. 112, second paragraph. The present claim 29 has been made independent so as not to conflict with claim 21. Claim 40 has been amended to provide a proper antecedent basis back to claim 21. Claims 41-43 have been amended to refer to more than one mode. Claim 54 has been canceled.

Claims 21-28, 33-40, 44-46, 48-51, and 53 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. The rejection is traversed. According to the Examiner:

It would have been obvious to one of ordinary skill in the art to treat the surface of the medium of the reference in order to obtain a desired level of gloss. The support may be paper, synthetic paper, or synthetic resin film [0025]. Based upon this disclosure, it would have been obvious to one of ordinary skill in the art to form the support of either transparent or opaque resin since both are well known and commonly used in the art.

...it would have been obvious to one of ordinary skill in the art to use any well known binder for ink receiving layers as the binder of the reference. Mr. Leon has stated in his first declaration that the acid number cannot be calculated without significant amounts of information concerning the polymerization reaction of the polyester resin. The acid number is not stated by the reference or calculable by the examiner. However, it would have been obvious to one of ordinary skill in the art to determine the acid number by monitoring and determining the appropriate degree of progress of formation reaction of the particles of Maeda et al. in order to result in desired crosslinked particles.

...it also would have been obvious to one of ordinary skill in this art to determine layer thicknesses and thickness of the medium overall in order to obtain necessary levels of ink absorption and required levels of machine feedability and handling characteristics of the media.” and “to include a gloss layer with smaller particles over an ink absorption layer including larger particles in order to achieve gloss in the coating of Maeda et al.

Maeda talks about having porous polyester beads in an inkjet receiver. He states that the particles have accelerated drying speed and high image durability. The reference provides: "The volume average particle size D of the particles used in the present invention is in the range of 0.5-100  $\mu\text{m}$ ." [0006] But, however, it is also stated that "If the average particle size of the hollow porous resin particles that form the absorbing layer is smaller than 1  $\mu\text{m}$ , there is almost no absorbing effect." Thus, since absorption is the function of inkjet media, the inkjet media invention does not extend to below 1  $\mu\text{m}$ . This is a clear teaching away. It is not relevant what size particles the synthesis might be able to make if the teaching of the reference does not extend to an ink jet media with the claimed particle size.

Further, the reference states that one can obtain particles having a volume-average particle size in the range of 1-100 $\mu\text{m}$  using the described synthesis. [0020] Thus, it does not appear that the size less than 1  $\mu\text{m}$  has been enabled.

In summary, the reference is non-enabling as to the ability to synthesize a particle of average size less than 1  $\mu\text{m}$  and is expressly lacking in any motivation or utility for providing ink jet media having particles of size less than 1  $\mu\text{m}$ .

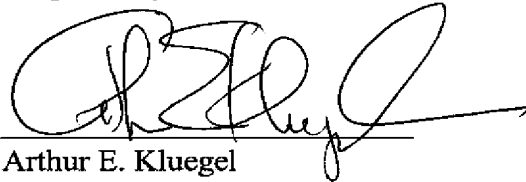
Although the Examiner has cited a passage suggesting a particle size of "about" 0.5 to 100 $\mu\text{m}$ , the term "about" is notoriously indefinite and to apply a broader range is contradicted by two other passages, one of which specifically says it does not work. Further, the size of particles used in the examples of the reference is 6.6 and 4.3  $\mu\text{m}$  [0032], well outside the less than 0.5 $\mu\text{m}$  of the present claims.

The Examiner may argue that she cannot patentably distinguish "0.5  $\mu\text{m}$ " from "less than 0.5  $\mu\text{m}$ ", but for the foregoing reasons, one of ordinary skill in the art would neither know how to make particles with size less than 1  $\mu\text{m}$  nor would he have any desire to do so in view of the "teaching away" remarks of the reference that less than 1 is unacceptable.

Claims 21-54 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. and further in view of Henry et al. or Martinson et al. The rejection is traversed. It is the conclusion of the Examiner that "...it would have been obvious to one of ordinary skill in the art to include bimodal particles in the medium of the primary reference in order to obtain improved

feedability and anti-blocking properties.” Since the secondary references do not remedy the deficiencies of the Maeda primary reference stated above, this rejection is inappropriate and should be withdrawn.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'A. Kluegel', written over a horizontal line.

Arthur E. Kluegel  
Attorney for Applicant(s)  
Registration No. 25,518

AEK:clb  
Rochester, NY 14650  
Telephone: (585) 477-2625  
Facsimile: (585) 477-1148